

**REMARKS**

Claims 1-9 are all the claims pending in the application.

Claim 9 has been amended as supported by the description at page 2, first and second paragraphs, and page 13, lines 1-15, of the specification.

No new matter has been added.

Referring to Section No. 1 at page 2 of the Office Action, the Examiner indicates that she has reopened prosecution in view of the Appeal Brief filed February 10, 2004. Referring to the options presented by the Examiner at Section No. 1, Applicants have elected to file a reply under 37 C.F.R. § 1.111.

Referring to Section No. 3 at pages 2 and 3 of the Office Action, Claims 1-3 and 5-9 are rejected under **35 U.S.C. § 103(a)** as being unpatentable over U.S. Patent No. 5,229,185 (US '185").

Independent Claim 1 recites "[a] water-permeable adhesive tape for processing semiconductor wafers and/or semiconductor related materials."

The Examiner acknowledges that the invention of US '185 is used for a different purpose. In particular, the speaker front sheet of US '185 is used in a sound outlet structure of an apparatus equipped with a speaker.

The Examiner asserts, however, that "since the tape of [US '185] is capable of performing the intended use and has the claimed structure, [US '185] meets that limitation."

Applicants respectfully traverse. The speaker front sheet of US '185 is clearly incapable of being used to process a semiconductor wafer and/or a semiconductor-related material. Thus, the adhesive layer 3 taught by US '185 differs in construction and function from the claimed water-permeable adhesive tape.

Specifically, the adhesive layer 3 of US '185 merely "extends along a peripheral portion of the perforated sheet." Applicants refer to column 2, lines 45-47, and FIG. 1.

## AMENDMENT

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A person of ordinary skill in the art of semiconductors immediately recognizes and understands that the particular adhesive layer arrangement of the speaker front sheets of US '185, wherein they "extend along a peripheral portion of the perforated sheet," renders the sheets useless for processing semiconductor wafers and/or semiconductor related materials. There is no plain adhesive layer in US '185, and there is only a perforated adhesive sheet having at one side a gauze material and at the other side an adhesive only at the edges.

Furthermore, a modification to US '185 that would extend the adhesive layer beyond the peripheral portion of the perforated sheet is impermissible because it would destroy the teachings of US '185 and render the speaker front sheets unsatisfactory for their intended purpose.

In particular, an adhesive layer that extends only along a peripheral portion of the perforated sheet is a necessary and essential element of US '185. As stated at column 2, lines 45-48, the adhesive layer extends only along a peripheral portion of the perforated sheet "so as not to hinder passage of sound waves through the speaker front sheet."

Finally, the patentability of the claimed adhesive tape may be also emphasized by noting that they are water-permeable, which is not the case for the subject matter of US '185.

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of this §103 rejection of Claims 1-3 and 5-9.

Referring to Section No. 4 at page 3 of the Office Action, Claim 4 is rejected under **35 U.S.C. § 103(a)** as being unpatentable over US '185 in view of JP 9-272850 ("JP '850").

Claim 4 depends from Claims 1 or 2, such that this rejection is directed to a dependent claim only. As noted above, US '185 does not disclose or suggest the claimed water-permeable adhesive tapes. JP '850 does not cure the deficiencies of US '185 identified above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this §103 rejection of Claim 4.

Referring to Section No. 5 at pages 3 and 4 of the Office Action, Claim 9 is rejected under **35 U.S.C. §112, second paragraph**, as being indefinite.

AMENDMENT

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Applicants respectfully traverse.

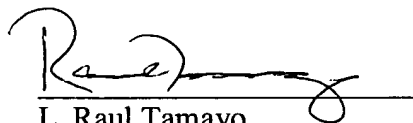
The meaning of amended Claim 9 is clear and definite when properly construed according to the teachings of the underlying disclosure, such as the disclosure at page 2, first and second paragraphs, and page 13, lines 1-15. For example, "fixing" means to apply the tape of Claim 1 to a semiconductor material. In each of Examples 1-5, a semiconductor wafer is bonded to an adhesive tape.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this §112 rejection of Claim 9.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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